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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,376	10/24/2005	Andreas Dietz	10537/289	3384
26646 7590 04/08/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
LEADER, WILLIAM T				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
04/08/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,376

Applicant(s)

DIETZ ET AL.

Examiner

WILLIAM T. LEADER

Art Unit

1795

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-22 is/are pending in the application.
- 4a) Of the above claim(s) 16-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-893)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 5/9/2005.

DETAILED ACTION

1. Receipt of the papers filed on February 26, 2008, is acknowledged. Claims 9-22 are pending.
2. Applicant's election of Group I, claims 9-15, in the reply filed on February 26, 2008, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. Claims 16-22 are withdrawn from consideration.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 9, 10, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Thoma et al (US 4,895,625).
6. The Thoma et al patent is directed to electrolytically depositing a protective coating on structural components such as gas turbine blades. See the abstract. The process includes the step of electrodeposition of Ni in a deposition bath in which particles including Al with no Cr are suspended. The particles become occluded in

the coating. See column 2, lines 44-54. The coated substrate is heat treated whereby the heat treatment causes alloying. See column 2, lines 54-58. Thus, all limitations recited in claim 9 are disclosed by Thoma et al.

7. With respect to claim 10, Thoma discloses passivating the particle surfaces. The passivation contributes to uniform film or layer structure. See column 3, lines 37-50. With respect to claim 14, Thoma discloses that the particles have diameters within the range of 1-15 μm (column 4, lines 4-6). This range falls within the range recited by applicant. With respect to claim 15, Thoma discloses in example 1 the deposition of a coating having a thickness of about 100 μm .

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thoma et al (US 4,895,625).

11. Claim 11 recites that the particles are alloyed with at least one of a) Ni, b) Co or c) Pt. Claim 13 recites that the particles are alloyed with Si. Thoma et al disclose that the particles may be chromium and/or aluminum containing metal alloy powders (column 2, lines 51-52). While Thoma et al do not specifically disclose Ni, Co, Pt or Si alloyed with aluminum, the inclusion of Ni, Co and Si as alloying elements in useful particles is disclosed at column 3, lines 62-65. It would have been obvious to have utilized Ni, Co or Si as an alloying element in aluminum alloy particles because Thoma et al disclose that these elements may be included in particles used in the practice of the invention.

12. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thoma et al in view of McMordie et al (5,650,235).

13. Claim 12 differs from the process of Thoma et al by reciting that the deposition bath includes suspended silicon particles. The McMordie et al patent is directed to the production of a corrosion resistant aluminide coating. The coating

may be formed by the application of an aluminum-silicon alloy powder (column 8, lines 22-28) or separate aluminum powder and silicon powder (column 6, lines 16-19), and heating to diffuse the aluminum and silicon into the substrate to form a stable and corrosion resistant coating (column 6, lines 19-25). The prior art of record is indicative of the level of skill of one of ordinary skill in the art. It would have been obvious at the time the invention was made to have included silicon powder with the aluminum powder suspended in the deposition bath in the electrolytic coating process of Thoma et al because a stable and corrosion resistant coating would have been produced as taught by McMordie et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM T. LEADER whose telephone number is (571) 272-1245. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Susy Tsang-Foster can be reached on 571-272-1293. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harry D Wilkins, III/
Primary Examiner, Art Unit
1795

/William Leader/
March 30, 2008